

Appl. No. 10/038,170
Atty. Docket No. 6768CD
Amdt. dated March 4, 2004
Reply to Office Action of November 17, 2003
Customer No. 27752

REMARKS

Claims 17, 22-25, 34, 39-42 are pending in the present application. No additional claims fee is believed to be due.

Claims 1-16, 18-21, 26-33, 35-38 are canceled without prejudice.

Claims 17, 22-25, 34, 39-42 have been amended to more specifically define the claimed invention of the present application. Support for the amendment is found in Examples 1, 3, and 4 at page 15, line 26 – page 18, line 10 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

37 CFR 1.133 Interview Summary

On March 4, 2004, Examiner Ogden and the attorney for the Applicants, Laura Grunzinger, discussed by telephone the amendments filed in the response filed February 17, 2004. Examiner Ogden requested clarification for the support of the amendments and arguments filed February 17, 2004. Specifically support for the Markush set of aromatic hydrocarbons in view of examples 1, 3 and 4; and the scope of support for the alkyl portion of the claimed composition.

The Markush set of aromatic hydrocarbons and alkyl portion of the claimed composition was found by Examiner Ogden not to be supported by examples 1, 3 and 4. Hence a further amendments to the claims were discussed which were supported by examples 1, 3 and 4, and shown in this supplemental amendment.

Rejection Under 35 USC 112, First Paragraph

The Office Action states Claims 10, 12-17, 19-27, 29-34, 36-42 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action further states that the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), as the time the application was filed, had possession of the claimed invention, specifically sufficient description for the alkyl aryl composition as claimed.

An applicant's specification must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, i.e., whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The test for

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sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." Ralston Purina Co. v. Far-Mar-Co., Inc., 227 USPQ 177, 179 (Fed. Cir. 1985). The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement. See MPEP §2163.02. The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. In re Wertheim, 191 USPQ at 98.

Applicants submit that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, what was in possession of the invention, i.e., whatever is now claimed. In the decision of Ex parte Sorenson, 3 USPQ2d 1462 (Bd. Pat. App. & Inter. 1987), it was decided that the subgeneric language of "aliphatic carboxylic acid" and "aryl carboxylic acid" did not violate the written description requirement because species falling within each subgenus were disclosed as well as the generic carboxylic acid. Similarly, Applicants submit that the claimed invention, as amended, would have been understood with reasonable clarity to those skilled in the art. For instance, Example 1 gives a process for making an alkylbenzenesulfonate surfactant system. Step (b) recites an alkylation step of alkylating a lightly branched olefin with an aromatic hydrocarbon. Page 15, line 26. Example 1 specifically recites benzene as the aromatic hydrocarbon. Page 15, lines 26-30. An alkylaromatic hydrocarbon, specifically an alkylbenzene product results. Page 15, lines 33-37. Example 1 then further recites that the alkylbenzene can then be shipped to a remote manufacturing facility. Page 15, line 37 – page 16, line 1. One of skill in the art will recognize the claimed composition of the present invention as the product of step(b) of Example 1. Similarly, Examples 3 and 4 also would be recognized by one of skill in the art as teaching the claimed composition of the present invention.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112, first paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 10, 13-17, 20-27, 30-34, and 37-42. If, prior to allowance, any outstanding issues exist, Applicants' attorney would welcome the opportunity to resolve such issues via a phone interview.

Respectfully submitted,

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